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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/153,782 09/16/98 BJORN

V 03022.P011

EXAMINER

WM31/0418

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ART UNIT

PAPER NUMBER

2621

DATE MAILED:

04/18/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

09/153,782

Applicant(s)

Bjorn et al

Examiner

Bhavesh Mehta

Art Unit

2621



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_\_
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirements.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some\* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 16) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 4 20) ☐ Other:

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## DETAILED ACTION

### *Information Disclosure Statement*

1. The information disclosure statement filed 5/8/00 fails to comply with 37 CFR 1.98(a)(1) and (2), which requires a list of all patents, publications, or other information submitted for consideration by the Office and which also requires a legible copy of each U.S. and foreign patent; each publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It appears that either the list and references were lost by the Office or were not filed by the applicants. Applicants are requested to provide a copy of the list as well as the references in response to this office action.

### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

3. Claims 1-2 and 5-31 are rejected under 35 U.S.C. 102(e) as being anticipated by O'Connor et al (US 5838306).

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O'Connor discloses substantially the claimed invention(see abstract and figures 1-2) including a touchpad device comprising:

a detection array having a detection surface configured to receive a fingerprint image (Fig 1 : 111, 113; see col. 3, line 50 - col. 4, line 15 and also col. 6, lines 38 - line 55) ;

and a processing device configured to receive the fingerprint image or image data from the detection array and wherein the processing device configures the touchpad device to operate as a pointer control device or a fingerprint recognition device based upon parameters associated with the fingerprint image(col. 3, lines 23-40; Figure 2; col. 4, lines 58-62).

Re claim 2, O'Connor further discloses a fingerprint platform configured to supply a fingerprint image to the detection surface of the detection array(Fig 2 : 201; see also col. 6, lines 48-55).

Re claim 5, O'Connor further discloses that the touchpad device is configured to operate as a pointer control device or a fingerprint recognition device based upon an area parameter associated with the fingerprint image (col. 4, lines 1-10; see also figure 2 : 201, 203; col. 6, lines 48-55).

Re claims 6-7, O'Connor further discloses first and second area median range (see figure 2 : 201 and 203 and col. 3, lines 7-22 wherein the CCD array 311 would encompass a full fingerprint image 201 corresponding to claimed first median range whereas partial processing of fingerprint data as set forth in col. 6, lines 62-65 corresponds to claimed second area median range).

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Re claim 8, O'Connor further discloses that the touchpad device is configured to operate as a pointer control device or a fingerprint recognition device based upon a pattern parameter associated with the fingerprint image (Fig 3 : 301, 303; col. 4, lines 63-67).

Re claims 9-12, O'Connor further discloses a first pattern which is a full fingerprint pattern and a second pattern which is a finger-tip print pattern (fig 3 discloses a first pattern which is a full fingerprint pattern whereas col. 6, lines 61-65 teaches partially processed fingerprint data corresponding to claimed second pattern which can be a finger-tip print pattern).

Re claim 13, O'Connor further discloses that the processing device is configured to translate the position of the fingerprint image on the detection surface into a cursor position on an interface area of a display when the touchpad device operates as a pointer control device (this is inherently the normal operation of the mouse of Figure 1 or Figure 4; see also at col. 3, lines 23-40).

Re claim 14, O'Connor discloses the both the area parameter and pattern parameter (see figures 2 and 3).

Claims 15-31 are similarly analyzed and rejected as the above claims.

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are

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such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 3-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over O'Connor in view of Keagy et al (US 5732148).

O'Connor has been discussed above. In fig. 3, O'Connor illustrates the fingerprint platform (see also col. 4, lines 62-67). However, he fails to specifically teach that the fingerprint platform comprises a sheet prism. However, the use of a sheet prism as a fingerprint platform is well known in the prior art. For example, in Figure 2 (see also Figures 3-4), Keagy discloses the sheet prism (finger print platen 10; see also col. 4, lines 30-35) being used as the fingerprint platform (see col. 6, lines 14-35). It would have been obvious to a person skilled in the art to use platen 10 or the micro prisms as shown by Keagy for fingerprint platform of O'Connor because such a modification will make the system of O'Connor at a sufficiently low cost and also improve the contrast of the fingerprint image (see Keagy at col. 4 lines 48-52 and lines 24-30).

Re claim 4, Keagy at col. 6, lines 20-40 teaches that the sheet prism is configured to focus the fingerprint image onto the detection surface.

6. Claims 1-2, 13, 15-16, 23 and 30-31 are rejected under 35 U.S.C. 102(a) as being anticipated by either Crawford (GB 2312040) or Rao et al (WO 98/11501).

Both of the above references discloses a mouse being used as a fingerprint sensor as well as a pointing device (see Figure 1 and pages 1-2 in Crawford and Figures 4a and 4b, page 13, line 32 - page 14, line 26 in Rao).

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7. Claims 1-2, 13, 15-16, 23 and 30-31 are rejected under 35 U.S.C. 102(e) as being anticipated by Kinsella (US 6148094).

Kinsella also discloses a pointing device incorporating a biometric sensor (see abstract, Figures 1-3; col.3, lines 40-50 and col. 11 lines 50-53).

8. Claims 1-4, 13, 15-16, 23 and 30-31 are rejected under 35 U.S.C. 102(e) as being anticipated by Borza et al (US 5991431).

Borza also discloses a mouse adapted to scan biometric data (see abstract, figure 3, col. 3, lines 10-17). Borza further discloses a sheet prism as claimed in claims 3-4(prism 12 in figure 4; see also multi prisms of Figures 23-25).

9. Claims 5-12, 14, 17-22 and 24-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Borza et al in view of O'Connor.

Both Borza and O'Connor have been discussed above. Borza fails to specifically disclose some of the limitations such as area parameter and pattern parameter. However, as discussed above, O'Connor discloses the claimed elements missing in Borza. Because, both the references discusses pointing devices incorporating biometric scanners, it would have been obvious to a person with ordinary skill in the art to combine the teachings of Borza and O'Connor for the purpose of reducing space required on a desktop and also allowing normal operation of the pointing device and at the same time providing a security function with out the need for additional hardware.

~~Allowance~~


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10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bhavesh Mehta whose telephone number is (703) 308-5246. The examiner can normally be reached on Monday-Thursday from 8:00 AM to 6:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Leo Boudreau, can be reached on (703) 305-4706. The fax phone number for the organization where this application or proceeding is assigned is (703) 306-5406.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4700.



Bhavesh Mehta  
Primary Examiner